of making embryonic stem cells from embryonic ectoderm cells, classified in Class 435, subclass 240.21, and Group VII contains Claims 32, 35, and 36, drawn to methods of screening growth factor compositions, classified in Class 435, subclass 4.

Applicants provisionally elect the claims of Group I, *i.e.*, Claims 1-7, 30, 31, 33, and 34 drawn to embryonic stem cell compositions, classified in Class 435, subclass 240.21, with traverse. Applicant requests that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims.

M.P.E.P. § 803 provides:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803.

The Examiner has not shown that the ***second*** requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and examine groups I, II, III, V and VI together, particularly since Groups I, II, III, V and VI are all in the same class and sub-class. Therefore, there is no extra burden on the Patent Office to keep all of these groups in this application, and indeed it would be most efficient for the Patent Office to keep all of these groups in the application. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

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No fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks Washington, D.C. 20231, on this 6th day of September, 1995.

David G. Perryman

9-6-95
Date

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